

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-20 are pending in the application, with claims 1 and 13 being independent claims. Claims 21-26 are sought to be canceled without prejudice to or disclaimer of the subject matter contained therein. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 103

Claims 1, 8, 13, and 15-16

Paragraph 5 of the Office Action rejects claims 1, 8, 13, and 15-16 under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 6,437,227 to Theimer, *et al.*, (“Theimer”) in view of U.S. Patent Appln. Pub. No. 2004/0100492 to Mercs (“Merces”). For at least the following reasons, Applicants respectfully request the Examiner reconsider and withdraw the rejection.

As Applicants explained in their prior response and acknowledged by the Examiner in paragraph 6 of the Office Action, “Theimer does not teach allowing the subscriber to listen to the music without prior providing a list of potential song titles to the subscriber.” To overcome this deficiency of Theimer, the Office Action proposes to

combine Mercs with Theimer. However, for at least the following reasons, Applicants respectfully assert that the proposed combination is improper.

I. Proposed combination impermissibly renders Theimer inoperable for its intended purpose

Applicants respectfully submit the proposed combination impermissibly renders Theimer inoperable for its intended purpose. As is well-established, references may not be combined as a *prima facie* basis in support of an obviousness rejection where the combination would render the reference being modified inoperable for its intended purpose. *See*, MPEP §2143.01(V).

In the present case, Theimer ***requires*** that a list of song titles be presented to the user. This requirement stems from Theimer's basis for operation. Theimer attempts to provide music to a user in response to the user's entering a rendition of a song's melody. (*See, e.g.*, Theimer at 5:35-38, "[t]o request a particular piece of music from a service provider, the user first enters a passage of the piece of music which is to be selected or is desired by simply singing the melody known to him into the microphone 14.") Based on this rendition, Theimer generates a pitch profile corresponding to the melody that would ideally match a melody in a database of stored songs. (*See, e.g.*, Theimer at 6:6-9, "[t]hus, a smoothed profile for the pitch frequencies of the sung tone sequence over time is produced, which ideally coincides with the profile for the melody in the frequency range.") However, Theimer recognizes that the user-entered melody may not be accurate. (*See, e.g.*, "[s]ince, however, ***conscious and unconscious transposition of the melody by the user when singing, and differences in rhythm and tempo, produce errors or discrepancies between the sung melody and the desired melody***, the profile of the pitch frequencies which is shown in FIG. 2 is quantized on the basis of the frequencies of

the musical tones or notes, with the result that the quantized profile shown in FIG. 3 for the pitch frequencies f_p over time is produced.” (Emphasis added.)) To account for this inaccuracy, Theimer estimates the difference between the user-entered tone sequence and tone sequences corresponding to music stored in a database. (*See*, Theimer at 7:11-52.) From these estimates, termed “correspondence factors,” Theimer creates a list of song titles to present to the user from which the user can select the desired song. (*See*, Theimer at 8:1-13, “[a]s soon as the note sequence for the entered tone sequence has been compared with all the note sequences in the individual pieces of music, the names or titles of the pieces of music are sorted according to the correspondence factors $F_{i,1}$ ascertained, starting with the smallest discrepancy factor, which denotes the highest degree of correspondence. In order subsequently to present the pieces of music to the user in the order ascertained, they are transmitted from the database station 12 to the mobile telephone 10, where the titles are displayed on the display device 24 while characteristic passages of the pieces of music can be output over the loudspeaker 23.”)

From the foregoing description of the operation disclosed in Theimer, Applicants respectfully assert that due to the inaccuracies inherent in the user-entered tone sequence, Theimer recognizes the system disclosed therein cannot conclusively determine which song a user desires. As a result without taking into account this inherent inaccuracy, the system may determine and store a song not desired by the user. For this reason, Theimer determines several songs based on the calculated correspondence factors to present to the user *so the user can choose* precisely which song he or she desires. That is, rather than risk storing the wrong song, and consequent user frustration, Theimer presents a list of possible song titles to the user so the user can select the desired song for storage.

Because the user can select the appropriate song from the presented list of song titles, Theimer's system may eliminate wrong song storage, frustration associated therewith, and inefficiencies associated with users having to re-enter tone sequences.

As a result, Applicants respectfully submit presentation of the list of song titles to the user is a necessary operation of Theimer, without which Theimer will not work for its intended purpose. Consequently, Applicants respectfully submit the proposed combination of Theimer with Mercks, which eliminates the required presentation of the list of song titles to the user, is impermissible by rendering Theimer inoperable for its intended purpose.

II. Proposed combination impermissibly changes the principle of operation of Theimer

Applicants respectfully submit the proposed combination is improper because it would impermissibly change the principle of operation of Theimer. As is well-established, references may not properly be combined as a *prima facie* basis in support of an obviousness rejection where the combination changes the principle of operation of the reference being modified. *See*, MPEP §2143.01(VI).

As described above, presentation of the list of song titles is necessary to the operation of Theimer so a user can choose the desired song and prevent storage of a wrong song due to inaccuracies in the user-entered tone sequence. However, the proposed combination of Theimer with Mercks eliminates the list of song titles from being prior presented to the user so the user can select the desired song. Applicants respectfully submit that eliminating this required feature of Theimer impermissibly changes the principle of operation of Theimer, much to the detriment of the user. For

example, as described above, not presenting a the list of song titles to the user subjects the user to storage of wrong songs and resulting frustration and inefficiency associated therewith. Consequently, Applicants respectfully submit the proposed combination of Theimer with Mercs, which eliminates the required presentation of the list of song titles to the user, is impermissible by changing the principle of operation of Theimer.

III. Theimer teaches away from the proposed combination with Mercs

Applicants respectfully submit the proposed combination is improper because the references teach away from the application of Mercs proposed in the Office Action. As is well-established, references may not properly be combined as a *prima facie* basis in support of an obviousness rejection where the references teach away from the proposed combination. (*See*, MPEP §2145(X)(D)(2).)

Theimer teaches presenting a list of song titles to a user so the user can select the desired song. In paragraph 6, the Office Action proposes to combine Theimer, with Mercs, for “allowing the subscriber to listen to the music ***without prior providing a list of potential song titles to the subscriber*** (para. 0062).” (Emphasis added.) However, as described above, presentation of the list of song titles to the user for selection is a ***necessary*** operation of Theimer. Mercs, on the other hand, is being proposed for exactly the opposite proposition, that is, operation ***without prior*** providing a list of song titles to the user so that the user can select the desired song. Applicants respectfully assert that as a result of the contrary disclosures in Theimer and Mercs, the references teach away from the proposed combination. Accordingly, Applicants respectfully submit the combination of Theimer with Mercs proposed in the Office Action is improper.

IV. Mercs does not teach “allowing the subscriber to listen to the music without prior providing a list of potential song titles to the subscriber”

Even if, assuming *arguendo*, the proposed combination of references is proper, Mercs does not disclose or suggest “allowing the subscriber to listen to the music without prior providing a list of potential song titles to the subscriber,” as alleged in the Office Action. As a result, Applicants respectfully submit that the proposed combination of Theimer in view of Mercs neither teaches nor suggests the combination of features set forth in claim 1 or claim 13.

Merces appears directed to a ubiquitous companion to allow a user to control and interact with devices on a network. (*See*, Merces at [0015].) As described in paragraph [0015] of Merces:

The user selects requests through the ubiquitous companion and the companion sends appropriate commands to agents operating on appropriate devices to carry out the selected commands. The companion reports the results of the commands back to the user, when appropriate.

Merces appears to disclose two modes for allowing a user to provide requests using the ubiquitous companion. The first mode provides a list of requests for selection by the user. The list is created using host and remote device data. A user can select a request from the list to control and interact with devices on a network (*See*, Merces at [0026], [0028].)

The second mode for allowing a user to select requests using the ubiquitous companion does not require that a list of requests first be provided to the user. As described in paragraph [0062] of Merces, in the second mode, “a user places a request using an open-ended selection interface, such as a speech recognition system or a

command prompt for text entry.” Because of the open-ended nature of the response, the system of Mercs must validate the request and determine whether it is complete. (Merces at [0069-0070].) If the request is not complete, the user is prompted to enter additional information to complete the request or told the request cannot be satisfied. (Merces at [0070].) When additional information is required, the user is prompted for the additional information via a request response that provides a sub-selection list from which the user selects an appropriate request (Merces at [0071]; *See also*, Merces at [0071], “[t]he companion provides the formatted request response to the host agent for presentation to the user through the host device, block 655, *and waits for a selection from the user*, returning to block 630.” (Emphasis added.))

From the foregoing, Applicants respectfully submit that the portion of Merces cited in the Office Action, that is paragraph [0062] deals solely with a request to control and interact with a device on a network. As a result, in the combination of Theimer with Merces, this portion of Merces concerns only a user request to store a song *not with eliminating Theimer’s requirement to select a song for storage after songs are returned in response to a request*, as explained above. As a result, Applicants respectfully assert that the proposed combination does not disclose or suggest “allowing the subscriber to listen to the music without prior providing a list of potential song titles to the subscriber” contrary to the allegation in the Office Action.

V. Conclusion with respect to rejection of claims 1, 8, 13, and 15-16

For at least the foregoing reasons, Applicants respectfully submit that the alleged combination of Theimer with Merces is impermissible. Even, if the proposed

combination is valid, Applicants respectfully submit the proposed combination does not disclose or suggest all features recited in claims 1 and 13 or their respective dependent claims 8 and 15-16. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claims 1, 8, 13, and 15-16 set forth in paragraph 5 of the Office Action.

Claims 2-3 and 14

Paragraph 9 of the Office Action rejects claims 2-3, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of Merces in further view of Official Notice. For at least the following reasons, Applicants respectfully request the Examiner reconsider and withdraw this rejection.

While acknowledging that the proposed combination of Theimer in view of Merces does not teach the particular features recited in claims 2-3, and 14, the Examiner takes official notice that such features would be obvious to those having ordinary skill in the art. Claims 2-3 depend ultimately from claim 1. Claim 14 depends from claim 13.

Without addressing the propriety of the rejection, Applicants respectfully assert the office notice relied upon by the Examiner, does not overcome the deficiency of the proposed combination of Theimer in view of Merces explained above with respect to claims 1 and 13. Thus, Applicants respectfully submit that the combination of Theimer in view of Merces in further view of the office notice neither teaches nor suggests the combination of features recited in claims 2-3 and 14. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 2, 3, and 14 set forth in paragraph 9 of the Office Action.

Claims 4-6

Paragraph 13 of the Office Action rejects claims 4-6 under 35 U.S.C § 103(a) as being unpatentable over Theimer in view of Merces in further view of U.S. Patent No. 7,356,557 to Kikuchi *et al.* (“Kikuchi”). For at least the following reasons, Applicants respectfully request the Examiner reconsider and withdraw the rejection.

Claims 4-6 depend directly or indirectly from claim 1. As explained above, the proposed combination of Theimer in view of Merces is not only improper, but also does not disclose each element of claim 1. Applicants respectfully assert that Kikuchi does not cure the deficiency of Theimer. Consequently, Applicants respectfully assert that the combination of Theimer in view of Merces with Kikuchi neither teaches nor suggests the combination of features recited in claims 4-6. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claims 4-6 set forth in paragraph 13 of the Office Action.

Claims 7 and 17

Paragraph 17 of the Office Action rejects claims 7 and 17 under 35 U.S.C § 103(a) as being unpatentable over Theimer in view of Merces in further view of U.S. Publication No. 2007/0177586 to Eyal *et al.* (“Eyal”). For at least the following reasons, Applicants respectfully request the Examiner reconsider and withdraw the rejection.

Claim 7 depends from claim 1. Claim 17 depends from claim 13. As explained above, not only is the proposed combination of Theimer in view of Merces improper, but it also does not disclose each element of claim 1 or claim 13. Applicants respectfully assert that Eyal does not cure the deficiency of the proposed combination of Theimer in

view of Mercs. Consequently, Applicants respectfully assert that the combination of Theimer in view of Mercs with Eyal neither teaches nor suggests the combination of features recited in claims 7 and 17. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claims 7 and 17 set forth in paragraph 17 of the Office Action.

Claims 9-11

Paragraph 20 of the Office Action rejects claims 9-11 under 35 U.S.C § 103(a) as being unpatentable over Theimer in view of Mercs further in view of 7,093,754 to Sako (“Sako”). For at least the following reasons, Applicants respectfully request the Examiner reconsider and withdraw the rejection.

Claims 9-11 depend directly or indirectly from claim 1. As explained above, not only is the proposed combination of Theimer in view of Mercs, improper, but it also does not disclose each element of claim 1. Applicants respectfully assert that Sako does not cure the deficiency of the proposed combination of Theimer in view of Mercs. Consequently, Applicants respectfully assert that the combination of Theimer in view of Mercs with Sako neither teaches nor suggests the combination of features recited in claims 9-11. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claims 9-11 set forth in paragraph 20 of the Office Action.

Claim 12

Paragraph 24 of the Office Action rejects claim 12 under 35 U.S.C § 103(a) as being unpatentable over Theimer in view of Mercs further in view of U.S. Patent No.

7,113,927 to Tanaka *et al.* (“Tanaka”). For at least the following reasons, Applicants respectfully request the Examiner reconsider and withdraw the rejection.

Claims 12 depends indirectly from claim 1. As explained above, not only is the proposed combination of Theimer in view of Merces improper, but it also does not disclose each element of claim 1. Applicants respectfully assert that Tanaka does not cure the deficiency of the proposed combination of Theimer in view of Merces. Consequently, Applicants respectfully assert that the combination of Theimer with Tanaka neither teaches nor suggests the combination of features recited in claim 12. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claim 12 set forth in paragraph 24 of the Office Action.

Claims 18-20

Paragraph 26 of the Office Action rejects claims 18-20 under 35 U.S.C § 103(a) as being unpatentable over Theimer in view of U.S. Publication No. 2005/0031314 to Galdos (“Galdos”). For at least the following reasons, Applicants respectfully request the Examiner reconsider and withdraw the rejection.

Claims 18-20 depend directly or indirectly from claim 13. As explained above, not only is the proposed combination of Theimer in view of Merces improper, but it also does not disclose each element of claim 13. Applicants respectfully assert that Galdos does not cure the deficiency of the proposed combination of Theimer in view of Merces. Consequently, Applicants respectfully assert that the combination of Theimer in view of Merces with Galdos neither teaches nor suggests the combination of features recited in

claims 18-20. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claims 18-20 set forth in paragraph 26 of the Office Action.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Amdt. dated March 15, 2010 - 17 -
Reply to Office Action of September 14, 2009

Fitzgerald, *et al.*
Appl. No. 10/713,143

Prompt and favorable consideration of this Amendment and Reply is respectfully
requested.

Respectfully submitted,

/David C. Isaacson/

David C. Isaacson
Registration No. 38,500

Date: March 15, 2010